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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,756	06/06/2000	Gabriel J. Hall	13237-2595-(MS-149378.1)	9536
27488	7590	05/26/2004	EXAMINER	
MERCHANT & GOULD P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/587,756

Applicant(s)

HALL ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-12-2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Application History

1. This action is responsive to the application amendment, application amendment filed on 3/12/2004.
2. Applicant has amended independent claims 1, 4 and 9 and dependent claims 6 and 11.
3. Applicant's amendment has cancelled dependent claim 8 and has added new independent claim 15.
4. Applicant has amended the claims in response to the objections cited by the examiner in the *Allowable Subject Matter* section of the previous Office Action (dated 12/24/2003). Applicant's amendment has addressed the objections previously made and therefore, in view of this amendment, objections to claim 8 are withdrawn.
5. The rejection of claims 1, 3 and 4 under 35 USC 102(e) as being anticipated by Yamaguchi, US Patent 6,098,069 has been withdrawn as necessitated by amendment.
6. The rejection of claims 2, 5-7 and 9-14 under 35 USC 103(a) as being unpatentable over Yamaguchi, US Patent 6,098,069 in view Apfel et al., US Patent 6,405,225of has been withdrawn as necessitated by amendment.
7. Claims 1-7 and 9-15 are pending in the case, claims 1, 4, 9 and 15 are independent claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

9. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by J. Palme, et al., "MIME Encapsulation of Aggregate Documents, Such as HTML (MHTML)," Mar 1999, Network Working Group, RFC 2557, pages 1-27 (herein after Palme).

10. **Regarding independent claim 1**, Palme recites: *"There are a number of document formats (Hypertext Markup Language [HTML2], Extended Markup Language [XML], Portable Document format [PDF] and Virtual Reality Markup Language [VRML]) that specify documents consisting of a root resource and a number of distinct subsidiary resources referenced by URIs within that root resource. There is an obvious need to be able to send such multi-resource"* (emphasis added, page 1, paragraph 1) and *"This aggregation into a single message of a root resource and the subsidiary resources it references may also be applicable to resources retrieved by other protocols such as HTTP or FTP, or to the archiving of complete web pages as they appeared at a particular point in time"* (emphasis added, page 1, paragraph 4).

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Palme further recites: *"Example of a multipart/related structure containing body parts with both Content-Location and Content-ID labels:*

```
Content-Type: multipart/related; boundary="boundary-example";
type="text/html"
--boundary-example
Content-Type: text/html; charset="US-ASCII"
... <IMG SRC="fiction1/fiction2"> ...
... <IMG SRC="cid:97116092811xyz@foo.bar.net"> ...
--boundary-example
Content-Type: image/gif
Content-ID: <97116092511xyz@foo.bar.net>
Content-Location: fiction1/fiction2
--boundary-example
Content-Type: image/gif
Content-ID: <97116092811xyz@foo.bar.net>
Content-Location: fiction1/fiction3
--boundary-example—"
```

(emphasis added, page 7, first paragraph)

11. **Regarding dependent claim 2**, Palme recites: *"MIME Encapsulation of Aggregate Documents, such as HTML (MHTML)"* (page 1, title).
12. **Regarding dependent claim 3**, Palme recites: *"a resource received in multipart/related structure is stored in a cache"* (page 22, paragraph 7).
13. **Regarding independent claim 4**, Palme recites: *"In order to transfer a complete HTML multimedia document in a single e-mail message, it is necessary to: a) aggregate a text/html root resource and all of the subsidiary resources it references into a single composite message structure, and b) define a means by which URIs in the text/html root can reference subsidiary resources within that composite message structure"* (page 1, paragraph 2).
Palme also discloses opening an HTML file on Page 14 in the example in

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Section 9.1. Palme further recites: "*A body part, such as a text/html body part, may contain URIs that reference resources*" (page 12, first paragraph). Palme also recites: "*supporting file content location*" and "*separate content type description*" as described in the rejection of claim 1 above.

14. **Regarding dependent claim 5**, the claim contains substantially the same subject matter as claim 2, and is rejected using the same rationale.

15. **Regarding dependent claim 6**, Palme recites: "*The second example is an HTML message which includes a single image, referenced using the Content-Location mechanism*" (page 14, section 9.2), which is followed by a related HTML source file as the root resource.

16. **Regarding dependent claim 7**, Palme recites: "*In order to transfer a complete HTML multimedia document in a single e-mail message, it is necessary to: a) aggregate a text/html root resource and all of the subsidiary resources it references into a single composite message structure*" (emphasis added, page 1, third paragraph).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

18. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi, US Patent 6,098,069, filed 3/4/1998, patented 8/1/2000 in view Palme.

19. **In regard to independent claim 9**, Yamaguchi discloses determining a webpage source file and the location of multiple supporting files in Fig. 4 at reference sign 26. Yamaguchi discloses the location files availability in Fig. 5(b) at reference sign S25 and Yamaguchi discloses saving data where the location is not available in Fig. 5(a) at reference sign S26.

Yamaguchi discloses the management of the webpage and source files, but Yamaguchi fails to disclose the file as an MHTML file. Palme teaches the use of an MHTML file. Palme recites: "*There are a number of document formats (Hypertext Markup Language [HTML2], Extended Markup Language [XML], Portable Document format [PDF] and Virtual Reality Markup Language [VRML]) that specify documents consisting of a root resource and a number of distinct subsidiary resources referenced by URIs within that root resource*" (emphasis added, page 1, paragraph 1).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made for the invention of Yamaguchi to have been capable of managing MHTML files as taught by Palme so as to realize the benefit that all "*In order to transfer a complete HTML multimedia document in a single e-mail message*" (Palme, page 1, third paragraph).

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20. In regard to dependent claim 10, Yamaguchi recites: *"the data managing device 1 is disposed in a commonly found information processing device (not shown) complete with a display screen, a keyboard, a CPU (Central Processing Unit), a recording medium"* (column 5, lines 41-44).
21. In regard to dependent claim 11, the claim is directed toward naming the web page source file with a leaf name. Yamaguchi discloses the use of leaf names for web page source files in Fig. 7 and Fig. 9.
22. In regard to dependent claims 12-14, the claims are directed toward locating supporting files inside a folder named after the MHTML file where: a file name does not exist for a main portion (claim 12), if the supporting files do not exist (claim 13), or if the supporting file do not exist in the same folder as the main portion (claim 14). The obvious use of the MHTML file is described above (see claim 9). Yamaguchi discloses locating supporting files together in reference to the main file, as shown in Fig. 2. Yamaguchi discloses testing to see if the supporting file exists in Fig 5(b) at reference sign S25.

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Allowable Subject Matter

23. Claim 15 is allowed.

Response to Arguments

24. Applicant's arguments with respect to claims 1-7 and 9-14 have been considered but are moot in view of the new ground(s) of rejection as stated above.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone


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number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
May 21, 2004


STEPHEN S. HONG
PRIMARY EXAMINER